UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,540	04/09/2004	Alan McMahon	018360/276712	1291

				EXAMINER	
826	7590	06/05/2007		PLUCINSKI, JAMISUE A	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/821,540	MCMAHON, ALAN
Office Action Summary	Examiner	Art Unit	
	Jamisue A. Plucinski	3629	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-21* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20040709, 20060130</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.   Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3.   With respect to Claims 1 and 11: the phrase "based on an extraction configuration files stored in the computer system" is indefinite. The claim has not previously recited an extraction configuration file and has not positively claimed that it has been stored. Therefore it is unclear to the examiner how the data is extracted based on a file, when the claim fails to positively claim that the file is there.

4.   With respect to Claims 1 and 11: the phrase "retrieving communications data parameters stored in the computer system" is indefinite. The claim has not positively claimed that any parameters are stored in the computer system. Therefore it is unclear to the examiner where these parameters come from.

5.   With respect to Claim 10: the phrase "an tracking number" is grammatically incorrect.

6.   With respect to Claim 10: the phrase "establishing a communications link between the computer system and a second computer" is indefinite. It is unclear to the examiner if this the same second computer that is claimed in Claim 1, or if this is another computer being claimed.

7.   Claim 12 recites the limitation "the computer system" in line 3. There is insufficient antecedent basis for this limitation in the claim.

8.   With respect to Claim 12: the phrase "retrieving a communication data parameter file" is

indefinite. The claim has not positively claimed that a communications data parameter files

being stored anywhere, therefore it is unclear to the examiner how and where to retrieve it from.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

10.   Claims 1, 3-9, 11-13, 15-21 are rejected under 35 U.S.C. 102(e) as being anticipated by

Williams et al. (US 2007/0073551).

11.   With respect to Claim 1: Williams discloses a method of processing parcel level detail

(PLD) data associated with a parcel (see abstract) that is able to be tracked during shipment

comprising:

    a.   providing a plurality of PLD data as input to a computer system (Paragraph

0251);

    b.   determining a tracking number associated with the parcel (Paragraph 0411);

    c.   associating the tracking number with the PLD data (Paragraph 0413);

    d.   storing the PLD data and the tracking number in a record in a parcel data file

stored in the computer system (Paragraph 0413);

e.   extracting at least a subset of the plurality of PLD data from the parcel data file

based on an extraction configuration file stored in the computer system (Paragraph 0489-

0490);

f.   retrieving communication data parameters stored in the computer system, the

communication data parameters comprising a first destination address (Paragraph 0255);

g.   transmitting an electronic communication message comprising the extracted

subset of the plurality of PLD data and the tracking number to the first destination

address (Paragraphs 0486-0488); and

h.   transmitting the parcel data file to a second computer (The information is inputted

into a web server, which is then sent to a system or a database server, See Figure 55,

which the examiner considers to be the second computer).

12.   With respect to Claim 3: Williams discloses the tracking number is determined in part by

the computer system executing an algorithm producing the tracking number (Paragraphs 0414-

0420).

13.   With respect to Claim 4: Williams discloses the tracking number is obtained by

requesting a server for the tracking number (Paragraph 0109).

14.   With respect to Claim 5: Williams discloses the step of transmitting an electronic

communication message occurs based on a pre-defined time schedule (End of Day Processing

Paragraph 0534).

15.   With respect to Claim 6: Williams discloses the destination address is an email address

(Paragraphs 0486-0488).

16.   With respect to Claim 7: Williams discloses the email address is provided by an operator

of the computer system (See Paragraph 0255).

17.   With respect to Claim 8: Williams discloses transmitting a second electronic

communication message including the tracking number to a second destination address

(Paragraphs 0486-0488).

18.   With respect to Claim 9: Williams discloses the use of a business reference number

associated with the parcel.

19.   With respect to Claim 11: Williams discloses the use of a method of processing parcel

level detail (PLD) data associated with a parcel that is able to be tracked during shipment (see

abstract) comprising:

    i.   initiating a shipping application on a local shipping system (See Figure 12 with

    corresponding detailed description);

    j.   providing a plurality of PLD data as input to a computer system wherein the

    plurality of PLD data include a destination address, class of service, and weight

    indication (See Figures 20 and 25 with corresponding detailed descriptions);

    k.   obtaining a tracking number; associating the tracking number with the PLD data

    (Paragraph 0411);

    l.   storing the PLD data and the tracking number in a record in a parcel data file

    stored in the computer system (Paragraph 0413);

m.   printing out a shipping label including at least a portion of the PLD data and the

tracking number (See Figure 52 with corresponding detailed description, as well as

Paragraph 0422);

n.   extracting at least a subset of the plurality of PLD data from the parcel data file

based on an extraction configuration file stored in the computer system (Paragraph 0489-

0490);

o.   retrieving communication data parameters stored in the computer system, the

communication data parameters comprising a first destination address (Paragraph 0255);

p.   transmitting an electronic communication message comprising the extracted

subset of the plurality of PLD data and the tracking number to the first destination

address (Paragraphs 0486-0487); and

q.   transmitting the PLD data file and the tracking number to a second computer (The

information is inputted into a web server, which is then sent to a system or a database

server, See Figure 55, which the examiner considers to be the second computer).

20.   With respect to Claim 12: _____ discloses the use of a computer readable medium storing

instructions to be executed on a computer comprising steps for:

r.   receiving parcel level detail (PLD) data as input to the computer system, the PLD

data associated with a parcel that is able to be tracked during shipment (Paragraph 0251);

s.   determining a tracking number associated with the parcel (Paragraph 0411);

t.   storing the PLD data and the tracking number in a record in a parcel data file

(Paragraph 0413);

u.   extracting a portion of the PLD data (Paragraphs 0413);

v.   retrieving a communication data parameter file comprising a user-defined

destination address (Paragraph 0255);

w.   transmitting an electronic communication message comprising the portion of the

PLD data and the tracking number to the destination address (Paragraph 0486-0487); and

x.   transmitting the parcel data file to a second computer (The information is inputted

into a web server, which is then sent to a system or a database server, See Figure 55,

which the examiner considers to be the second computer).

21.   With respect to Claim 13: Williams discloses the portion of the PLD data is determined

by an extraction configuration file (Paragraph 0179).

22.   With respect to Claim 15: Williams discloses the steps of:

y.   prompting a user to enter an address associated with the transmission of the

electronic communication message, receiving the address and storing the address in a

communication data file (Paragraphs 0179 and 0255).

23.   With respect to Claim 16: Williams discloses the step of formatting a shipping label

based in part on the PLD data (Paragraph 0422).

24.   With respect to Claim 17: Williams discloses the use of an apparatus comprising:

z.   a database storing parcel level detail (PLD) shipping data in a plurality of records

(Central Database 22), the database further storing tracking number related data from

which a tracking number can be derived (Paragraph 0416), the database further storing a

first and second destination address (Paragraphs 0255, 0486-0488);

aa.   a processor (see Paragraph 0255) receiving input comprising PLD data, the

processor configured to store the PLD data in the database (Paragraphs 0255 and 0413),

the processor further configured to determine a tracking number based on the tracking

number related data (Paragraph 0411) and store the tracking number in the database

(Paragraph 0413), the processor further configured to extract a subset of the PLD data

and communicate the subset of PLD data and the tracking number to a second destination

address (Paragraphs 0486-0488); and

bb.   an interface (Paragraph 0095) for receiving from the processor the subset of PLD

data and the tracking number and transmitting the tracking number over a

communications network using the first address indicated by the processor (See Figures

59-62 with corresponding detailed description).

25.   With respect to Claim 18: Williams discloses the processor is further configured to

communicate the tracking number using the first destination address based on a periodic

schedule (End of Day Processing, Paragraph 0534).

26.   With respect to Claim 19: Williams discloses the processor is further configured to

communication the PLD data to the second destination address (Paragraphs 0486-0488).

27.   With respect to Claim 20: Williams discloses the tracking number related data stored in

the database comprises a plurality of tracking numbers (See Figure 63 with corresponding

detailed description).

28.   With respect to Claim 21: Williams discloses the database further stores an extraction

configuration file used to determine the subset of PLD data to be extracted (See Paragraohs 0179

and 0255).

Claim Rejections - 35 USC § 103

29.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

30.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

31.   Claims 2, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Williams in view of Kucharczyk et al. (US 6,300,873).

32.   With respect to Claims 2, 10 and 14: Williams discloses the use of an algorithm for

generating tracking numbers (See Paragraphs 0414-0420) however fails to disclose the use of

storing them in an a tracking inventory file, and determining the tracking number by selecting

one tracking number from the file. Kucharczyk discloses the use of a files which stores a list of

codes (the examiner considers a tracking number to be a form of a code, and the list to be list of

numbers which are assigned to a particular transaction), which are generated prior to use, and

stored in a server for use. It would have been obvious to one having ordinary skill in the art at

the time the invention was made, to modify Williams, to have the tracking numbers stored in a

file, as disclosed by Kucharczyk, in order provide precise control over the tracking numbers and

to ensure the tracking number is only used once during a particular time. (See Kucharczyk,
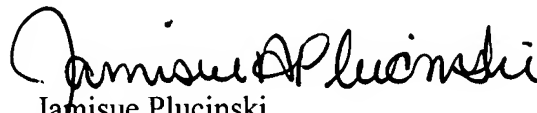
Columns 7 and 8).

Conclusion

33.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. Karbowski et al (6,772,130) discloses the use of a system which tracks parcels and

sends e-mail notification and Hilbush et al. (US 2005/0038758) discloses the use of a shipping

system with label generation and tracking shipments.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811.

The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jamisue Plucinski
Patent Examiner
Art Unit 3629